

### **REMARKS**

Before this amendment, Claims 1-14 and 27 were pending in the above-captioned patent application. Through this amendment, Claim 2 has been cancelled and new Claims 57-62 have been added. As such, Claims 1, 3-14, 27 and 57-62 are now pending in the above-captioned patent application. Claims 1, 3-14 and 27 have been amended to further clarify the claimed limitations. New matter has not been added.

Claims 2-14 were rejected under 35 U.S.C. § 112, Second Paragraph. The claims have been amended to overcome the rejections.

Claims 1 – 3, 5, 9 and 27 were rejected under 35 U.S.C. 102(b) as being anticipated by US Patent No. 5,955,417 (“Taylor”). The rejections under 35 U.S.C. 102(b) are respectfully traversed because Taylor does not disclose all of the claimed limitations, as amended.

Claims 4 and 8 were rejected under 35 U.S.C. 103(a) as being unpatentable over Taylor in view of US Patent No. 3,284,963 (“Lanham”). Claims 8-11 and 14 were rejected under 35 U.S.C. 103(a) as being unpatentable over Taylor. Claim 13 was rejected under 35 U.S.C. 103(a) as being unpatentable over Taylor in view of US Patent No. 6,171,007 (“Hsu”). Claims 1, 3 and 6 were rejected under 35 U.S.C. 103(a) as being unpatentable over Taylor in view of US Patent No. 5,022,517 (“Benitez”). Claim 12 was rejected under 35

U.S.C. 103(a) as being unpatentable over Taylor in view of US Patent No. 5,960,506 ("Reuven"). All of these rejections under 35 U.S.C. 103(a) are respectfully traversed because the references, alone or in combination, do not teach or suggest all of the claimed limitations, as amended.

#### **A. Rejections Under 35 U.S.C. § 112**

Rejection of Claims 2 – 14 were under 35 U.S.C. § 112, Second Paragraph, is respectfully traversed as it appears that the claims were rejected based on what was perceived by the Patent Office as an apparent contradiction between "pourable" and "solid."

#### **Meaning of Pourable Soap**

Independent Claims 1, and 27, as well as dependent Claims 3-14, have been amended to clarify the nature of "pourable soaps" as being solid. In the amended claims, the cleansing composition is now referred to as a "solid cleansing agent pourable soap."

As explained in the Expert Declaration of Dr. Jungermann (hereinafter "Jungermann Declaration"), a "pourable soap" is a cleansing agent that is in essentially solid form at a first temperature range, and in essentially pourable molten form at a second temperature range. This aspect of "pourable soap" is specifically noted in originally-filed Claim 15. As explained by Dr. Jungermann in Paragraph 7 of his Declaration, a "pourable soap" is a particular type of cleansing

agent – a solidified soap having a melting point above about 120°F, generally in the temperature range of from about 120°F to about 160°F.

Claims 1, 3-14 and 27 have been amended to clarify the solid nature of “pourable soap” which is solid at room temperature. When heated to temperatures above about 120°F, the solid “pourable soap” melts and becomes “pourable.” After cooling, the soap hardens and returns to its original solid form. The claimed invention is thus directed to cleansing pads comprising solid cleansing agent that are pourable above a specified melting point.

Applicants have also amended Claim 6, to provide antecedent basis for the claim element “substrate.” In addition, as recommended by the Examiner, for purposes of consistency, Applicants have amended the preamble of each of Claims 3 – 14 to recite “pad” in place of “device.”

For the above-stated reasons, Applicants respectfully submit that the amended claims fully comply with the requirements of 35 U.S.C. §112, Second Paragraph, and request that rejections under this section be withdrawn.

**B. Rejection of Claims 1 – 3, 5 and 9 Under 35 U.S.C. § 102**

Claims 1 – 3, 5, 9 and 27 were rejected based on the teachings of Taylor. Claims 1, 3 and 6 were also rejected based on the teachings of Benitez. For the following reasons, Applicants respectfully traverse.

## **1. Pourable Soap**

“Pourable soap” is a specific type of “soap” – one which, as explained in the Jungermann Declaration, would be understood differently by persons of ordinary skill in the personal care arts than the unqualified term “soap.” Persons of skill in the personal care arts would understand “soap” to be a mixture of sodium or potassium salts of mixtures of fatty acids from which glycerin is removed. See Jungermann Declaration, ¶¶ 4 – 5.

In contrast, pourable soaps are produced from fats and oils without removal of the liberated glycerine. When heated to approximately 120°F - 160°F, pourable soaps melt and become liquid. Importantly, when cooled below the melting point range, pourable soaps are reconstituted in solid form without having undergone significant changes in composition. Soaps do not melt at elevated temperatures; instead, they decompose, char or burn. See Jungermann Declaration, ¶¶ 6 – 7.

## **2. Taylor Does Not Teach Solid Pourable Soaps**

The rejection of Claims 1 and 2 seems to be based on an interpretation of the term “liquid” to mean “pourable.” As discussed above in Section A of the Remarks, “pourable soap” is a term of art that would be understood by persons of skill in the art to mean cleansing agents that are solid, not liquid.

The starting cleansing composition taught by Taylor is first constituted as a “liquid surfactant blend” created through the addition of a solvent, e.g. water. Taylor, Col. 2, lines 47 – 51 (emphasis added). That liquid is then impregnated in a web. The impregnated web, in turn, is dried to remove excess water.

In contrast, the cleansing compositions of the claimed invention are melted from solid pourable soap form prior to being applied to a cleansing pad which is then reconstituted (*i.e.*, solidified) into the starting pourable soap. As discussed below and explained in the Jungermann Declaration, the cleansing compositions taught by Taylor would not be understood by a person of skill in the art as being a solid pourable soap: “Taylor teaches liquid detergent systems and soaps, not pourable soaps.” See Jungermann Declaration, ¶ 7.

Taylor is primarily directed to liquid detergent compositions which are synthetic in nature. More specifically, the detergent systems taught by Taylor include non-ionic and ionic surfactants. Non-ionic surfactants taught by Taylor are high hydrophilic-lipophilic balance (“HLB”) alkyl ethoxylated phenols or alcohols (described in the Jungermann Declaration as alkyl polyethers), specific ethanolamides, and amine oxides. Anionic surfactants taught by Taylor are specific sulfonates and sulfates. None of these compounds are pourable soaps

Applicants note that Taylor generally – without elaboration or guidance – describes an alternative cleaning composition as one that “may comprise fatty

acid based soaps such as tallow fatty acid, coconut fatty acid, or a mixture of both.” Taylor continues to describe this soap as “suitably liquid at elevated temperatures, with a relatively high temperature set point, of a semi-solid bar-like character at typical room temperatures.” Taylor, Col. 4, lines 42 – 47.

As discussed in the Jungermann Declaration, the fatty acid based soaps as described in the preceding paragraph would not be understood by persons of skill in the art as pourable soaps of the type claimed in the present application. Instead, the soaps disclosed in Taylor would be understood by persons of ordinary skill in the art to mean soap from which glycerin has been removed. As discussed in Section B.1 of the Remarks and in Paragraph 6 of the Jungermann Declaration, “pourable soaps” contain glycerin; soaps do not.

Additionally, as discussed in the Jungermann Declaration, soaps do not melt on heating; instead they char, decompose or ignite. As set out in Paragraph 9 of the Jungermann Declaration, persons of skill in the art would understand this and, accordingly, would not consider melting soaps of the type taught by Taylor in the manner claimed in the present application.

For the above reasons, Applicants respectfully traverse the rejections of Claims 1 – 3, 5, 9 and 27 under 35 U.S.C. §102(b) based on Taylor.

**3. Benitez Does Not Teach Pourable Soap**

As explained in the Jungermann Declaration, the term “bar soap” would, without more, be understood by a person of ordinary skill in the art to mean a soap, not a pourable soap. More particularly, Benitez is directed to bar soaps which, as discussed in Section B.2, decompose when melted; pourable soaps do not. Accordingly, a person of ordinary skill in the art would not understand Benitez as teaching a cleansing pad comprising a pourable soap. For this reason, as well as the reasons set out in the previous section showing patentable distinctions between pourable soaps and soaps, including bar soaps, Applicants respectfully traverse the rejections of Claims 1, 3 and 6 under 35 U.S.C. §102(b) based on Benitez.

**C. Rejection of Claims 4, 8 - 14 Under 35 U.S.C. § 103(a)**

Under 35 U.S.C. 103(a), an invention is obvious where each claimed element is taught or suggested either (a) in a combination of prior art references or (b) by a single reference in combination with a principle or specific understanding within the knowledge of a skilled artisan that would have motivated the skilled artisan to make the claimed invention. As discussed below neither of these two types of obviousness has been established.

Further, it is well settled that the reference itself must suggest the modification or combination proposed in order for the modification or combination to be valid; “[the] invention cannot be found obvious unless there was some explicit teaching or suggestion in the art to motivate one of ordinary skill to



combine elements so as to create the same invention.” *Winner International Royalty Corp. v. Wang*, No. 96-2107, 48 USPQ.2d 1139, 1140 (D.C.D.C. 1998) (emphasis added). “The prior art must provide one of ordinary skill in the art the motivation to make the proposed molecular modifications needed to arrive at the claimed compound.” *In re Jones*, 958 F.2d 347, 21 USPQ.2d 1941, 1944 (Fed. Cir. 1992) (emphasis added). There is no suggestion from either of the references that they be combined or modified as proposed by the Office Action. Moreover, the Office Action fails to provide the necessary impetus for the modification.

**1. The Combination of Cited Prior References Do Not Teach or Suggest Each Element of the Claimed Invention**

A solid cleansing agent pourable soap is a required claim element of each claim that is the subject of the present Office Action. As discussed above, Taylor does not teach or suggest use of a pourable soap in a cleansing pad. In order to establish a *prima facie* case of obviousness, a secondary reference would not only need to disclose the required pourable soap claim element but also would need to suggest the desirability of combining that specific type of soap with the teachings of Taylor in a manner such that a skilled artisan would have a reasonable expectation of creating the claimed invention without undue experimentation. As discussed below, none of the secondary prior art references cited in the Office Action satisfy these criteria.



Rejection of Claims 4 and 8 under 35 U.S.C. §103(a) as being unpatentable over Taylor in view of Lanham, is respectfully traversed. The cleansing agent disclosed in Lanham is a pellet or tablet of soap, a synthetic detergent, or a combination of a soap and detergent in a solid or semisolid form. See, Lanham, col. 3, lines 19 – 22. As discussed in Paragraph 8 of the Jungermann Declaration, cleansing agents of the types taught by Lanham would not be understood by persons of ordinary skill in the art as pourable soaps.

Rejection of Claim 12 under 35 U.S.C. §103(a) as being unpatentable over Taylor in view of Reuven is respectfully traversed. Reuven teaches “soap” and particularly “antifungal soap” to help prevent fungal growth on the foot. As discussed above, persons of skill in the art, without some other specific suggestion or teaching, would not interpret “soap” to mean “pourable soap”. See Jungermann Declaration, ¶ 7.

Rejection of Claim 13 under 35 U.S.C. §103(a) as being unpatentable over Taylor in view of Hsu is respectfully traversed. The cleaning substance taught in Hsu is a soap material in the form of a washing cake. See, Hsu, Col. 2, lines 60 – 65. Persons of skill in the art would not interpret soap material to mean “pourable soap”. See Jungermann Declaration, ¶ 7.

A second requirement for a *prima facie* case of obviousness is that the modification or combination of the prior art would create a reasonable

expectation of success. *Amgen, Inc. v. Chugai Pharmaceutical Co.*, 927 F.2d 1200, 1207-08, (Fed. Cir.), *cert. denied*, 502 U.S. 856 (1991). As discussed in the Jungermann Declaration, a person of ordinary skill in the art would not have a reasonable expectation of success that by melting a soap – of the type taught by Taylor, Lanham, Reuven, and Hsu – a molten soap could be created which could be contacted with a sponge or other substrate and allowed to cool and dry creating a cleansing pad of the type claimed in the present application. A person of ordinary skill in the art would, in Dr. Jungermann's words, "think just the opposite. A person of skill in the art would not attempt to melt a soap, knowing that doing so would result in charring or igniting of the soap." See Jungermann Declaration, ¶ 8.

For the above reasons, Applicants respectfully traverse the rejections based on the combined teachings of (i) Taylor and Lanham; (ii) Taylor and Reuven; (iii) Taylor and Hsu.

**2. Obviousness is Not Established by Taylor in View of the Level of Ordinary Skill in the Art**

Rejection of Claims 8 – 11 and 14 under 35 U.S.C. §103(a) as being unpatentable over Taylor in combination with the knowledge that is "well-within the level of ordinary skill", is respectfully traversed.

A statement that modifications of the prior art – here Taylor – to achieve the claimed invention would have been "well within the ordinary skill of the art" is

not sufficient to establish a *prima facie* case of obviousness without some objective reason to combine the teachings of the references. *Ex parte Levengood*, 28 USPQ2d 1300 (Bd. Pat. App. & Inter. 1993). *See also In re Kotzab*, 217 F.3d 1365, 1371, 55 USPQ2d 1313, 1318 (Fed. Cir. 2000) (reversing obviousness rejection because there was no finding as to the principle or specific understanding within the knowledge of a skilled artisan that would have motivated the skilled artisan to make the claimed invention).

The Office Action fails to set out the principle or specific understanding within the knowledge of a skilled artisan that would have motivated the skilled artisan to make the claimed invention.

**D. New Claims 57- 61**

Pourable soap is also claimed in originally-filed Claim 15 (directed to a melting point of between 120°F and 200°F), and more particularly claimed in newly-filed Claim 57. Newly-added Claim 57 claims a pourable soap as a cleansing agent that is in essentially solid form at a first temperature range, and in essentially pourable molten form at a second temperature range.

Newly-added Claim 58 claims the temperature range of from about 120°F to about 160°F as the temperatures at which the solid cleansing agent pourable soap is transformed from a solid to an essentially molten form that is pourable.

Support for newly-added Claims 57 and 58 are found in originally-filed Claims 14 and 15.

A particular aspect of the present invention is directed to cleansing pads comprising natural pourable soaps, but not syndets. This aspect of the invention is claimed in newly-added Claims 59 – 61. Specifically, newly-added claims 59 – 61 are directed to the nature of the soap – one that is natural and is not synthetic (*i.e.*, syndets). Support for these claims is found in Paragraph [0032]. For at least the reasons provided herein above, the references do not teach or suggest the limitations of the new Claims 57-61.



**Conclusion**

For the above reasons, it is respectfully submitted that the rejection of the rejected claims should be withdrawn, and all of the claims be allowed.

Accordingly, reexamination, reconsideration and allowance of all the claims are respectfully requested. If the Examiner believes that an interview will expedite allowance, please contact undersigned counsel.

Please direct all correspondence to **Myers, Dawes Andras & Sherman, LLP**, 19900 MacArthur Blvd., 11<sup>th</sup> Floor, Irvine, California 92612.

Attachment: 1.132 Affidavit of Dr. Eric Jungermann – 5 pages.

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Respectfully submitted,

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